

REMARKS

This is a timely reply to the Office Action of January 12, 2005. In the Office Action, the Examiner rejected pending claims 1-16, and allowed Claims 17-24. The Applicants respectfully request that the Examiner consider the arguments presented in
5 below, and allow the claims, currently pending in this application.

The Applicants thank the Examiner for his allowance of Claims 17-24.

This application has been carefully reviewed in light of the Office Action of January 12, 2005, wherein:

- 10 A. Claims 1, 6, 7, 9, 14 and 15 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,234,609 to Huber et al, herein referred to as the "Huber patent;" and
- B. Claims 2-5, 8, 10-13 and 16 are rejected under 35 USC 103(a) as being unpatentable over the Huber patent in view of U.S. Patent No. 5,745,617 to Starodubov, herein referred to as the "Starodubov patent."

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CLAIM REJECTIONS – 35 USC §102

A. The Examiner rejected Claims 1, 6, 7, 9, 14 and 15 under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,234,609 to Huber et al. herein referred to as the "Huber patent."

20 **Claim 1**

On page 2 of the Office Action, the Examiner rejected Claim 1 under 35 USC 102 as being anticipated by the Huber patent. Specifically, the Examiner stated that the Huber patent illustrates in figure 3, a fiber laser (14) formed into a ring [applicant's tight curve], having a pump source (10), a grating (40) [applicant's Bragg grating], and an
25 optical isolator (16). The optical isolator provides a single polarization, col. 3, lines 58-61. Col. 4, lines 34-35 describes the grating (40) as a Morie grating which is a superposition of two Bragg gratings (col. 4, lines 41-43). Col. 4, lines 63-65 discloses the gratings induced by photorefractive effect [applicant's non-destructive technique]. The Applicants respectfully disagree that the Huber patent teaches each and every element of
30 Claim 1.

In order to establish a prima facie case of anticipation, the Examiner must set forth an argument that provides (1) a single reference (2) that teaches or enables (3) each of the claimed elements (as arranged in the claim) (4) either expressly or inherently and (5) as interpreted by one of ordinary skill in the art. All of these factors must be present, or a case of anticipation is not met. Thus, “[a]nticipation requires that every element of the claims appear in a single reference ...” *Continental Can Co. USA v. Monsanto Co.* 948 F.2d 1264 (Fed. Cir. 1991).

Claim 1 claims, “A method for generating a single polarization output from a fiber laser comprising the steps of using a non-destructive technique to fabricate a Bragg grating within the fiber laser and forming the fiber laser at the grating position into a tight curve.”

The preamble of Claim 1 states that it claims a method “for generating a single polarization output from a fiber laser.” MPEP section 2111.02 states “[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim,” citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). In this case, the preamble of Claim 1 does give life into the claim by stating that the steps are how a single polarization output from a fiber is generated. The Applicants submit that the Huber patent does not teach, disclose or suggest that a single polarization output is generated by “using a non-destructive technique to fabricate a Bragg grating within the fiber laser and forming the fiber laser at the grating position into a tight curve,” as is claimed in Claim 1.

Col. 4, lines 34-37 of the Huber patent teach that the grating resonator structure 40 is to provide mode selection. As stated in col. 3, lines 56-62, the optical isolator 16 is of the type that only passes one polarization. Thus, the Huber patent teaches that the grating structure is used to provide mode selection, while an optical isolator is needed to provide an single polarization output. Thus, the Huber patent does not teach, disclose, or suggest “a method for generating a single polarization output from a fiber laser ... [by] forming the fiber laser at the grating position into a tight curve,” as is claimed by Claim 1.

In addition, Claim 1 claims, in part, "forming the fiber laser at the grating position into a tight curve." The Examiner asserts that the ring of the Huber patent is the "tight curve" of the Claim 1. The Applicants respectfully disagree.

5 The Applicants assert that the Claim 1 claims, "forming the fiber laser at the grating position into a tight curve." However, the Huber patent shows forming the fiber laser into a ring. While, the Huber patent does show that that grating is part of the ring so is the optical isolator, and part of the Er doped fiber. Thus, the Applicants submit that the ring of the Huber patent is not formed "at the grating position into a tight curve," as is claimed in Claim 1.

10 For the reasons given above, the Applicants submit that Claim 1 is patentable over the cited prior art.

Claims 2-8

15 Claims 2-8 are dependent upon Claim 1. For the reasons given above, the Applicants submit Claim 1 is patentable over the art cited by the Examiner. Therefore, the Applicants submit that claims 2-8 are also patentable over the art cited by the Examiner at least though their dependency on an allowable base claim.

Claims 9-16

20 The same arguments presented above in favor of the patentability of Claim 1 can also be applied to Claim 9. As such, the Applicants submit that Claim 9 is also patentable over the cited prior art. Therefore, the Applicants submit that Claim 9 contains patentable subject matter and should be allowed. As such, the Applicants further submit that Claims 9-16 are also patentable at least through their dependence upon an allowable
25 base claim.

Concluding Remarks:

5 The Applicant respectfully submits that in light of the above comments and remarks, all claims are now in allowable condition. The Applicant thus respectfully requests timely allowance of all of the pending claims.

 In the event the Examiner wishes to discuss any aspect of this response, or believes that a conversation with either Applicant or Applicant's representative would be beneficial the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

10 The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to the attached credit card form or deposit account no. 50-2691. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months
15 necessary to make this response timely filed. The petition fee due in connection therewith may be charged to the attached credit card form or deposit account no. 50-2691.

Respectfully submitted,

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25 Date


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